

REMARKS/ARGUMENTS

In light of the amendments and arguments presented, Applicant respectfully requests reconsideration of the Non-Final Office Action dated July 12, 2007.

I. General Remarks Regarding the Content of this Amendment

Upon entry of this Amendment, claims 7-23 and 30-37 will remain pending in this application. Through this Amendment, Applicant has amended claim 13 into independent form. Further, claims 38-43 have been added to describe additional aspects of the invention. Support for these changes may be found, for example, at paragraph 21, 30 and 39-41 of the original specification and further, in original Figures 1-3 and 7.

Applicant makes the above noted claim changes for purposes of expediting prosecution and to facilitate the early allowance of this application. This action should not be construed as an admission or acknowledgement that Applicant agrees with any grounds of rejection raised in the Non-Final Office Action of July 12, 2007. Applicant reserves all rights with respect to the original and/or previously submitted claims, including the right to present claims of the same or similar scope in the future (*e.g.*, in a continuing application).

For the reasons described above, Applicant submits that no new matter is included in this Amendment.

II. Applicant's Claims Patentably Distinguish from the Cited Art

A. Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34, 36, and 37 Patentably Distinguish from Davis

Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by Davis, et al., U.S. Patent No. 6,857,204 (hereinafter "Davis"). *See* the July 12, 2007, Non-Final Office Action at page 2. Applicant respectfully traverses this rejection and requests reconsideration.

Applicant's independent claims 7, 16 and 30 recite a mesh or braided panel of a foot-receiving device (claims 7 and 30) or article of footwear (claim 16) closure system that at least partially extends around the foot-housing member (claims 7 and 30) or upper member (claim

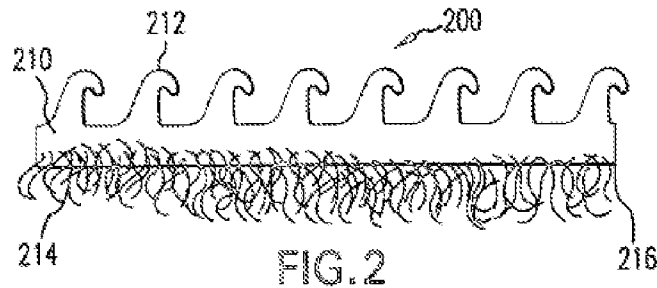
16), over a top instep portion of the foot-housing member or upper member from a lateral side of the foot-receiving device (or article of footwear) to a medial side of the foot receiving device (or article of footwear). Davis does not teach or suggest this claimed mesh or braided panel arrangement.

The Office alleges that Davis's outer member 134 is the recited closure mechanism, however, the Office concedes that Davis does not disclose that outer member 134 is a mesh or braided material. *See* the Non-Final Office Action at page 2. The Office alleges that it would have been obvious to one of ordinary skill in the art to have made outer member 134 from a mesh or braided material. *Id.* at page 2-3. Applicant respectfully disagrees that it would have been obvious to make the outer member from a mesh or braided material.

Initially, as noted by the Office, Davis discloses that the upper 112 can be made from a mesh material, but does not say the same of the outer member 134. Therefore, Davis does not supply any teaching or suggestion that the outer member could be made from a mesh material. In fact, if there is any implication from this silence, it is that Davis did realize that parts of the shoe could be made from mesh, and did not intend that the outer member 134 could be made from mesh. Further, there are several disclosures in Davis that support this by actually teaching away from making the outer member 134 from mesh.

First, Davis discloses that the outer member 134 is comprised of a hook and pile closure material. *See* Davis at col. 6, lines 14-15. Hook and pile fasteners, such as VELCRO®, rely on the contact between the hooks and pile in order to operate. Hence, removing pieces of the pile material in order to create a mesh would actually reduce the fastening ability of the hook and pile fastener. Therefore, Davis teaches away from the outer member 134 including a mesh material, because the mesh would actually lessen the fastening ability of the hook and pile fastener.

Second, the Office's motivation of modifying Davis to provide a mesh material in order to allow the footwear to breathe and ventilate itself would not apply to Davis. *See* FIG. 2 of Davis reproduced below which discloses a cross-section of outer member 134.



As seen in FIG. 2, the base 210 is a solidified plastic resin (col. 6, lines 20 *et seq.*). Merely substituting a mesh material as the pile material 214 would not alter the non-porous nature of the plastic layer and, therefore, not aid the in footwear breathing or ventilating itself. Hence, substituting a mesh material as the pile material 214 would be superfluous. Therefore, Applicant respectfully submits that Davis actually teaches away from including a mesh material in the outer member 134 and to modify Davis to include a mesh material would merely be impermissible hindsight. Therefore, Applicant respectfully submits that such a modification would not be obvious to one of ordinary skill in the art.

Third, Davis discloses that the outer member 134 provides support and stability to inner member 124. *See* Davis at col. 6, lines 11-12. Modifying Davis's outer member 134 to be a mesh material would reduce the support and stability the outer member 134 could provide to the inner member 124. Therefore, Davis teaches away from such a modification and Applicant respectfully submits that such a modification would be against the plain teachings of Davis.

Accordingly, for at least these reasons, Applicant respectfully submits that these claims patentably distinguish from Davis. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

B. Claims 13-15, 21-23, 36, and 37 further Patentably Distinguish from Davis

Claim 13 has been amended to be in independent form. Claim 13 requires "a secondary closure system for holding the foot in the foot-housing member." In the Non-Final Office Action, the Office alleges the secondary closure system to be a shoelace base securing system.

See Non-Final Office Action at page 3. The Office, therefore, concludes that it would have been obvious to apply the teachings of Davis to a “shoe having a shoelace base securing system ... so that the wearer can better customize the fitting of the shoe.” *Id.* However, as discussed below, modifying Davis in the manner suggested by the Office would destroy the intended function of Davis. It is not *prima facie* obvious to modify a structure disclosed in a reference such that its intended function is destroyed. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, claim 13 is not obvious in view of Davis.

The Office has alleged Davis’s outer member 134 is the recited closure mechanism and suggested that it would be obvious to apply outer member 134 to any shoe having a shoelace base securing system. See the Non-Final Office Action at page 3. However, Davis specifically teaches away from a shoelace base securing system.

First, Davis focuses on eliminating a shoelace base securing system. In describing conventional shoelace based systems, Davis states, “because eyelets are in a fixed location, the lacing can not easily be tailored to a specific user, forcing every wearer, regardless of foot-shape or sensitivity, to have the laces cross the foot in the exact same place every time the shoe is worn. Thus lacing tends to be uncomfortable and can be burdensome.” See Davis at col. 1, lines 55-61. Therefore, Davis directs his invention to a shoe with a customizable closure system which avoids a shoelace base securing system and the alleged discomfort caused thereby. Clearly, upon a fair reading of Davis, one of ordinary skill in the art would not include a shoelace base securing system, because doing so would defeat the intended function of Davis.

The Office relies on Davis’s statement that, “the closure system can be used on any shoe requiring a closure system, including athletic shoes, casual shoes dress shoes, women’s shoes and any types of boots.” See the Non-Final Office Action at page 3. However, Applicant respectfully submits that this statement does not teach or suggest using two closure systems in a single shoe. Instead, it teaches Davis’s outer member 134 being used in place of any other closure system and teaches away from the outer member 134 being in used in addition to any secondary securing system. Davis’s disclosure is focused on preventing irritation and discomfort caused by laces or multiple layers of material. See *e.g.* Davis at col. 1, line 60 or col. 2, line 29, respectively. For example, in the background section, Davis notes conventional shoes that have

multiple layers of material stacked together and the irritation and discomfort caused by such a multi-layered construction. *See* Davis at col. 2, lines 26 *et seq.* Further, Davis describes such layering as “bulky and unwieldy.” *Id.* Davis then goes on to describe a need to which his invention is directed is the need of “providing a simple and non-bulky closure system.” *See* Davis at col. 3, lines 12-13.

Clearly Davis teaches away from adding his outer member 134 to a system that already has a closure mechanism because merely adding another closure mechanism would defeat the purposes of Davis’s invention namely (1) reducing the irritation and discomfort caused by laces or multiple layers of material and (2) reducing the shoe’s bulkiness and unwieldiness. Therefore, upon a fair reading of Davis, Applicant respectfully submits that Davis teaches away from the claimed language “a secondary closure system” and modifying Davis to include one is impermissible hindsight. Claims 14, 21, 22 and 36 have similar language (including claims 14 and 22 reciting a shoelace based securing system) and similar arguments apply.

Accordingly, Applicant respectfully submits that these claims patentably distinguish from Davis. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

C. Claims 15, 23 and 37 further Patentably Distinguish from Davis

Applicant’s claims 15, 23, and 37 further patentably distinguish from Davis. These claims recite that the mesh or braided panel-including closure system at least partially covers a secondary closure system. For the reasons recited above, Davis teaches away from a secondary closure system. Therefore, Davis cannot teach or suggest this feature of claims 15, 23 and 37. Accordingly, Applicant respectfully submits that these claims patentably distinguish from Davis. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

D. New Claims 38, 39 and 40 further Patentably Distinguish from Davis

Applicant’s claims 38, 39 and 40 further patentably distinguish from Davis. Claim 38 recites that the mesh or braided panel is a braided panel. A braided panel is clearly not disclosed

by Davis. For example, as seen in FIG. 2, the pile material 214 is not braided and further, there would be no reason to braid such pile material 214.

Claim 39 recites a plurality of plastic strands wherein the plastic strands each extend from at least one edge of the panel to at least another edge of the panel. This feature is clearly not taught of suggested by Davis. Davis does not disclose plastic strands. Further, Davis clearly does not teach or suggest that the plastic strands each extend from at least one edge of the panel to at least another edge of the panel.

Claim 40 recites the plurality of plastic strands, each of which extends from at least one edge of the panel to at least another edge of the panel, are in a braided arrangement such that the angles of the strands to one another produce open areas between the various strands. This feature is clearly not taught of suggested by Davis. Clearly, Davis does not teach or suggest a plurality of plastic strands, each of which extends from at least one edge of the panel to at least another edge of the panel, are in braided arrangement such that angles of the strands to one another produce open areas between the various strands.

Accordingly, Applicant respectfully submits that this claim patentably distinguish over Davis. Withdrawal of the rejections and allowance of this claim is earnestly solicited.

E. New Claim 41 further Patentably Distinguishes from Davis

Applicant's claim 41 further patentably distinguishes from Davis. This claim recites that the closure system includes a border around the mesh or braided panel, wherein the border is a different material than the mesh or braided panel.

Davis discloses an outer member 134. Outer member 134 is completely comprised of hook and pile material. *See e.g.* Davis at col. 7, line 1. The Office has alleged that it would be obvious for this outer member 134 to be a mesh or braided panel. *See Non-Final Office Action* at page 2. Even assuming (without conceding) that outer member 134 were a mesh or braided panel, there is no border around the outer member 134. Further, there is no border made of a material which is different from the mesh or braided panel. Therefore, Davis cannot teach or suggest this feature of claim 41. Accordingly, Applicant respectfully submits that this claim

patentably distinguishes over Davis. Withdrawal of the rejections and allowance of this claim is earnestly solicited.

F. New Claim 42 further Patentably Distinguishes from Davis

Applicant's claim 42 further patentably distinguishes over Davis. This claim recites that the mesh or braided panel is a substantially continuous panel which completely covers the secondary closure system.

Claim 42 recites that the mesh or braided panel is substantially continuous. First, Davis does not disclose a mesh or braided panel. Second, even assuming (without conceding) that outer member 134 were a mesh or braided panel, the outer member 134 is not substantially continuous. For example, as seen in Davis's FIG. 3 the vamp straps 314 alternate with the openings in the outer member and leave gaps therebetween. One advantage of the mesh or braided panel of the present application is that it will prevent the laces from becoming entangled with the wearer's feet even if the laces inadvertently become united. *See* Applicant's specification at paragraph 33. The gaps in Davis do not provide a substantially continuous panel and therefore cannot provide the same advantage (Although it is noted that Davis, in fact, teaches away from a secondary closure mechanism such as laces).

Secondly, claim 42 recites that the mesh or braided panel completely covers the secondary closure system. For the reasons recited above, Davis teaches away from a secondary closure system. Therefore, Davis cannot teach or suggest this feature of claim 42.

Accordingly, Applicant respectfully submits that this claim patentably distinguishes from Davis. Withdrawal of the rejections and allowance of this claim is earnestly solicited.

G. New Claim 43 further Patentably Distinguishes from Davis

Applicant's claim 43 further patentably distinguishes over Davis. This claim recites the braided panel includes a plurality of strands in a braided arrangement such that open areas are defined between the strands and further wherein the open areas between the strands contract and expand in response to movement of the foot-receiving device.

A braided panel is clearly not disclosed by Davis. For example, as seen in FIG. 2, the pile material 214 is not braided and further, there would be no reason to braid such pile material 214. Further, Davis clearly does not teach or suggest a plurality of strands in a braided arrangement such that open areas are defined between the strands and further wherein the open areas between the strands contract and expand in response to movement of the foot-receiving device. Therefore, Davis cannot teach or suggest this feature of claim 43.

Accordingly, Applicant respectfully submits that this claim patentably distinguishes from Davis. Withdrawal of the rejections and allowance of this claim is earnestly solicited.

H. Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34, 36, and 37 Patentably Distinguish from the Combination of Davis and Monti

Claims 7, 8, 10, 11, 13-17, 19, 21-23, 30, 31, 33, 34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious from the combination of Davis in view of U.S. Patent No. 6,599,057 to Monti (hereinafter “Monti”). *See* the Non-Final Office Action at pages 3-4. Applicant respectfully traverses this rejection and requests reconsideration.

For the reasons stated above with respect to Davis, Applicant respectfully disagrees that it would have been obvious to make the outer member 134 from a mesh or braided material.

There are several disclosures in Davis that actually teach away from making the outer member 134 from mesh and therefore the combination of Monti and Davis would not be obvious to one of ordinary skill in the art.

First, Davis discloses that the outer member 134 is comprised of a hook and pile closure material. *See* Davis at col. 6, lines 14-15. Hook and pile fasteners, such as VELCRO®, rely on the contact between the hooks and pile in order to operate. Hence, removing pieces of the pile material in order to create a mesh would actually reduce the fastening ability of the hook and pile fastener. Therefore, Davis teaches away from the outer member 134 including a mesh material, because the mesh would actually lessen the fastening ability of the hook and pile fastener.

Second, the Office’s motivation of modifying Davis to provide a mesh material in order to allow the footwear to breathe and ventilate itself would not apply to Davis. *See* FIG. 2 of

Davis which discloses a cross-section of outer member 134. As seen in FIG. 2, the base 210 is a solidified plastic resin (col. 6, lines 20 *et seq.*). Merely substituting a mesh material, such as Monti's, as the pile material 214 would not alter the non-porous nature of the plastic layer and, therefore, not aid the in footwear breathing or ventilating itself. Hence, substituting a mesh material would be superfluous. Therefore, Applicant respectfully submits that Davis actually teaches away from including a mesh material in the outer member and to modify Davis to include a mesh material would merely be impermissible hindsight. Therefore, Applicant respectfully submits that such a modification would not be obvious to one of ordinary skill in the art.

Third, Davis discloses that the outer member 134 provides support and stability to inner member 124. *See* Davis at col. 6, lines 11-12. Modifying Davis's outer member 134 to be a mesh material, such as Monti's, would reduce the support and stability the outer member 134 could provide to the inner member 124. Therefore, Davis teaches away from such a modification and Applicant respectfully submits that such a modification would not be obvious to one of ordinary skill in the art.

Accordingly, Applicant respectfully submits that these claims patentably distinguish from the combination of Davis and Monti. Withdrawal of the rejections and allowance of these claims are earnestly solicited.

III. Conclusion

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or to place the application in condition for allowance, he is invited to contact the undersigned attorney.

Applicant believes that a 1-month extension of time fee is due for entry and consideration of this Amendment. If, however, the Office determines that any other fees are required, such as fees under 37 C.F.R. §§ 1.16 and/or 1.17, or if an additional extension of time is necessary that is not accounted for in the documents filed with this Amendment, the Commissioner is authorized

Application of Michael R. Friton – U.S. Patent Appln. No. 10/776,242

to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pending status of this patent application.

All rejections having been addressed, Applicant respectfully submits that this application is in condition for immediate allowance. Allowance of this application is earnestly solicited.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: /Matthew Kohner/
Matthew J. Kohner
Registration No. 51,892

BANNER & WITCOFF, LTD.
1100 13th Street, N.W., Suite 1200
Washington, D.C. 20005-4051
(202) 824-3000 (Telephone)
(202) 824-3001 (Facsimile)

Dated: November 13, 2007